



AF/ 1/2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Inventor(s)	:	Terry L. Oehrke
Serial No.	:	09/594,070
Filing Date	:	June 14, 2000
Title	:	COMPUTER NETWORK METHOD AND SYSTEM FOR GUARANTEED MESSAGING SERVICE
Group/Art Unit	:	2144
Examiner	:	Scott B. Christensen
Docket No.	:	1234

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellant submits this Reply Brief in response to the
Examiner's Answer mailed on September 15, 2008.

Certificate of Mailing Under 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the
United States Postal Service with sufficient postage as first class mail
in an envelope addressed to Mail Stop Appeal Brief – Patents,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
1450, on:

Date: October 17, 2008
Signature: Shela R. Gibson
Printed Name: Shela R. Gibson

The Director is hereby authorized to charge
any additional amount required, or credit any
overpayment, to Deposit Account No.
19-4409.

REMARKS

I. Appellant's claims 1, 3-5, 7-9, 11-13, and 15-19 are neither anticipated by nor obvious in view of *Nelson*.

A. The Board has already decided that Appellant's claims are not obvious in view of *Nelson* and other references, thus, the Board should reverse the Examiner's rejection of the claims based on *Nelson*.

The Board of Patent Appeals and Interferences, in its July 31, 2007 decision in Appeal No. 2007-1044, already reversed a rejection of Appellant's claims under 35 U.S.C. § 103(a) over U.S. Patent Number 5,974,122 to Nelson et al. ("*Nelson*") in combination with other references. The Examiner has now rejected independent claim 1, and dependent claims 3-5 and 7-8, on the basis that they are anticipated by *Nelson*. If the claims are not obvious over *Nelson*, then they are also not anticipated by *Nelson*. Further, the Examiner rejected independent claim 9, and dependent claims 11-13 and 15-19, as obvious in view of *Nelson* and an Internet reference. The Internet reference does not disclose any more than the references that the Board previously evaluated in combination with *Nelson*. Therefore, the Board's previous decision is still appropriate, and the Examiner's rejection of all of the claims based on *Nelson* should be reversed.

The Examiner asserts that his rejection does not contradict the Board's previous decision because the Board only reviewed *Nelson* as a proposed reference to modify another patent and did not evaluate the claims solely in view of *Nelson*. Examiner's Ans., Issue 1, p.22. While the Board's decision does not expressly state that *Nelson* does not anticipate the claims, it is implicit in the Board's reasoning that the claims are not obvious over *Nelson*. Further, in describing *Nelson* the decision states that:

5. Nelson describes a facsimile system wherein the facsimile message is stored on a messaging platform only if the destination is unavailable at the first time and is transmitted a second time

when the destination becomes available (Abstract; col. 1, 1. 65 through col. 2, 1. 7).

Board Decision Appeal No. 2007-1044, p.4. This passage from the Board's decision summarizes the message routing system of *Nelson*. The passage does not describe invoking another messaging server if the original destination server is not operational because *Nelson* does not disclose this limitation, as discussed fully below. Because the Board has already found that the claims are not obvious in view of *Nelson* and other references, the Board should reverse the Examiner's rejection of the claims based on *Nelson*.

B. *Nelson* does not disclose invoking another messaging server as required by independent claims 1 and 9.

In response to Appellant's arguments that *Nelson* does not disclose invoking another messaging server, the Examiner states that Appellant does not define what is meant by "invoking." Examiner's Ans., Issue 3, p.24. The Examiner reasons that "invoking" could be interpreted as "using," and thus the fax messaging platform of *Nelson* (Fig. 2, item 134) is "invoked" to deliver a message. *Id.* The Examiner's interpretation, however, is inconsistent with the specification.

Claims must be interpreted in a manner that is consistent with the specification. MPEP § 2111. Appellant's specification states that:

By invoking messaging server 18, relay server 16 designates messaging server 18 as the destination of messages for particular addresses or domain names, such as addresses originally intended for messaging server 14. In other embodiments, relay server 16 notifies a different server of the unavailability of messaging server 14. This other server then invokes messaging server 18 to act as the destination for messages.

'070 Application, p.5, line 28 to p.6, line 3. Thus, when a server is invoked, it is designated as the destination for messages. Accordingly, the Examiner's interpretation of "invoking" as "using" is inconsistent with the specification.

Even if "invoking" was interpreted to mean "using," *Nelson* still does not anticipate claim 1, or make obvious claim 9, because *Nelson* does not disclose "another messaging server." *Nelson* discloses a system and method for delivering a facsimile message to an intended destination. If the destination is initially unavailable, the facsimile message is stored on a messaging platform. *Nelson*, Col. 2, Lines 30-33. The messaging platform repeatedly re-attempts transmission of the facsimile to the destination. Col. 2, Lines 33-41. If transmission to the destination is unsuccessful after several re-attempts, a message is sent back to the originator of the facsimile message, informing them that the delivery could not be accomplished. Col. 2, Lines 51-63. Thus, *Nelson* does not disclose invoking another messaging server to allow delivery of the message when the destination does not become operational.

The Examiner maintains that the Fax Messaging Platform 134 of *Nelson* meets both the "another messaging server" and "relay server" limitations of claims 1 and 9. Examiner's Ans., pp.4 & 24. The Examiner is wrong. *Nelson* does not disclose Fax Messaging Platform 134 acting as the "relay server" and invoking itself as the "another messaging server" if the original fax recipient does not become operational. Accordingly, *Nelson* neither anticipates independent claim 1, nor makes obvious independent claim 9.

With respect to dependent claim 3, the Examiner argues that because claim 3 does not state where the message is routed from, the Fax Messaging Platform 134 of *Nelson* can be equivalent to both the relay server and another messaging server in claim 3. Examiner's Ans., p.24. When dependent claim 3 is read as a whole, along with all the limitations of independent claim 1 from which claim 3 depends, it is clear that in step (e) the message is routed from the relay server to the other messaging server of step (d). Step (b) requires providing the message to a relay server when the original messaging server is inoperable. Step (d) requires invoking

another messaging server if the original messaging server does not become operational. Finally, step (e) requires routing the message to the other messaging server of step (d). Thus, the message is routed from the relay server to the other messaging server if the original messaging server does not become operational. The specification also supports this interpretation of claim 3 in stating: "The other messaging server receives the message from the relay server and processes the message for presentation to the recipient (i.e. destination user)." '070 Application, p.4, line 28 to p.5, line 1.

The Examiner also argues that a reference need not disclose step (d) of claim 1 to anticipate the claim, and thus, *Nelson* anticipates claim 1. Examiner's Ans., p.25. A reference must disclose all the limitations of a claim to anticipate that claim, MPEP § 2131, and because *Nelson* does not disclose "invoking another messaging server" it does not anticipate claim 1. The Examiner's argument is based on an erroneous interpretation of claim 1. This interpretation is the Examiner's primary basis for rejecting claim 1 based on U.S. Patent Application Publication Number 2001/0036822 to Mead et al ("*Mead*"). Examiner's Ans., pp.27-30. Therefore, Appellant addresses this argument in more detail in Section III.A. of this brief which addresses the Examiner's rejection of claim 1 based on *Mead*.

For the reasons above, Appellant requests that the Board reverse the rejection of claims 1, 3-5, and 7-8 as anticipated by *Nelson*, and claims 9, 11-13, and 15-19 as obvious in view of *Nelson*.

C. The Examiner has not met his burden to prove the publication date of the "DNS (domain name system)" reference cited against claims 9, 11-13, and 15-19.

The Examiner maintains that the "DNS (domain name system)" reference was available on February 29, 2000 according to the "Wayback Machine." Examiner's Ans., Issue 4, p.25. As submitted in the Evidence Appendix to the Appeal Brief, the website cited by the Examiner has a

publication date of February 16, 2004. The Examiner argues that the difference in dates may be because a hyperlink is now associated with the term "access provider" and on the Wayback Machine there was no hyperlink. Id. Appellant maintains that the Examiner has not met his burden under MPEP § 2128 to prove the date of publication for this Internet reference. The Examiner has not shown that the Wayback Machine is a reliable source of information, as evidenced by the different publication dates.

Regardless of whether this reference was available before the filing date of Appellant's application, the reference does not disclose "invoking another messaging server." Therefore, the reference does not correct the deficiencies of *Nelson*. Accordingly, the Board should reverse the Examiner's rejection of claims 9, 11-13, and 15-19.

II. Appellant's claims 1, 3-5, 7-9, 11-13, and 15-19 are neither anticipated by nor obvious in view of *Ozzie* because *Ozzie* does not disclose invoking another messaging server.

The Examiner maintains that U.S. Patent Number 6,859,821 to Ozzie et al. ("*Ozzie*") discloses invoking another messaging server as required by Appellant's independent claims 1 and 9. Examiner's Ans., Issue 6, p.26. First, the Examiner argues that there is no explicit requirement as to what entails "invoking." Id. As discussed above in Section I.B. with respect to the Examiner's rejection based on *Nelson*, claims must be interpreted in a manner that is consistent with the specification. MPEP § 2111. The specification provides that when a server is invoked it is designated as the destination for messages. '070 Application, p.5, line 28 to p.6, line 3. Therefore, the specification gives meaning to the term "invoking." *Ozzie* does not disclose invoking another messaging server according to this meaning, and thus, the Examiner's rejections based on *Ozzie* should be reversed.

The Examiner also argues that the relay of *Ozzie* (Item 814 in Fig. 8; Col. 16, Lines 43-54) meets both the relay server and another messaging server limitations of claims 1 and 9.

Examiner's Ans., pp.6 & 26. The relay of *Ozzie* cannot be both the relay server and another messaging server. *Ozzie* does not disclose relay 814 "invoking" itself. Instead, if the destination peer unit of *Ozzie* does not become available, then the message is not delivered. *Ozzie*, Col. 16, Lines 43-54.

The Examiner also argues that a reference need not disclose step (d) of claim 1 to anticipate the claim, and thus, *Ozzie* anticipates claim 1. Examiner's Ans., p.26. A reference must disclose all the limitations of a claim to anticipate that claim, MPEP § 2131, and because *Ozzie* does not disclose invoking another messaging server it does not anticipate independent claims 1 and 9. As discussed above in Section I.B. with respect to the Examiner's rejection of *Nelson*, this argument by the Examiner is based on an erroneous claim interpretation that was the Examiner's primary basis for rejecting the claims based on *Mead*. Accordingly, this argument is addressed in more detail below in Section III.A. of this brief.

For the reasons above, Appellant requests that the Board reverse the Examiner's rejection that claims 1, 3-5, 7-9, 11-13, and 15-16 are anticipated by *Ozzie*, and that claims 17-19 are obvious in view of *Ozzie*.

III. Claims 1, 3-5, 7-9, 11-13, and 15-19 are not anticipated by *Mead*.

A. Claims 1, 3-5, and 7-8

The Examiner argues that claim 1 is anticipated by *Mead* because *Mead* discloses step (a) of claim 1, and because steps (b), (c), and (d) of claim 1 are not required claim limitations. Examiner's Ans., Issue 7, pp.27-28. The Examiner argues that because each of steps (b), (c), and (d) includes a conditional statement, claim 1 can be anticipated by a reference that does not disclose these steps. *Id.* at 28-29. The Examiner's interpretation of claim 1 is erroneous. A reference must disclose all the limitations of a claim in order to anticipate that claim. MPEP § 2131. The Examiner's interpretation is inconsistent with the language of claim 1. The preamble

of claim 1 indicates that the claim comprises all four of the claimed steps, not just step (a). The preamble states: "A method for providing a messaging service on a computer network, the method comprising the **steps** of:" (emphasis added). Because the plain language of claim 1 requires all of the claimed steps, a reference must disclose all four of the claimed steps to anticipate claim 1.

The Examiner argues that there are three possible embodiments of claim 1 that occur based on the following three conditions: (1) the messaging server is operable; (2) the messaging server is inoperable, but then becomes operable; and (3) the messaging server is inoperable and never becomes operable. Examiner's Ans., pp.29-30. The Examiner states that disclosure of any one of these three embodiments anticipates the claim. Id. The Examiner is wrong. As indicated by the preamble, claim 1 is directed toward a method comprising four steps. Each of those steps must be disclosed in a single reference to anticipate the claim. MPEP § 2131. It is undisputed that *Mead* does not disclose steps (b), (c), and (d) of claim 1. Accordingly, the Examiner's rejection should be reversed.

The Examiner also argues that a reference need not disclose all of the alternatives of a Markush group to anticipate the limitation. Examiner's Ans., p.29. This argument is not relevant to the present situation because claim 1 does not include a Markush group. The Examiner also states that "[t]o anticipate a claim, a reference must disclose the claim as a whole." Examiner's Ans., p.29. *Mead* does not disclose claim 1 as a whole. As indicated by its preamble, claim 1 is a method claim "comprising the steps of" (a), (b), (c), and (d). *Mead* does not disclose each of the four steps required by claim 1. Accordingly, *Mead* does not anticipate claim 1.

Further, the Examiner's interpretation of claim 1 is erroneous because the Examiner's interpretation is inconsistent with the specification. As stated below, the specification describes a preferred embodiment that includes each of the four steps required by claim 1.

A first user sends a message to a destination user. The message includes a mail exchange record or other identifying information to identify a server associated with the destination user. If the destination server or a connection to the destination server is inoperable, the message is re-routed to a relay server in addition to or as an alternative to returning the message to the sender as undeliverable. The relay server provides reliable messaging by attempting to re-route the message to the destination server. Once the destination server becomes operable, the message is provided to the destination server for the destination user.

If attempts to re-route the message from the relay server to the destination server are unsuccessful, the relay server may invoke another messaging server. This other messaging server assumes the original IP address of the original messaging server and acts as a redundant backup to the inoperable destination messaging server. The other messaging server receives the message from the relay server and processes the message for presentation to the recipient (i.e. destination user). The relay server, alone or in conjunction with the other messaging server invoked by the relay server, provides reliable messaging in a computer network.

'070 Application, p.4, line 15 to p.5, line 3. Thus, the preferred embodiment described in the specification, along with the preamble of claim 1, support an interpretation of claim 1 that requires all four steps of the claim. Because *Mead* does not disclose all four steps, *Mead* does not anticipate claim 1, or claims 3-5 and 7-8, which depend from claim 1.

B. Claims 9, 11-13, and 15-19

The Examiner states that *Mead* anticipates independent claim 9 because the term "operable" only requires that the DNS server is capable of routing messages as claimed. Examiner's Ans., Issue 8, p.30. The Examiner also states that operable means "capable of being put into use, operation, or practice." *Id.* at 31. The Examiner's argument is based on a broad interpretation of claim 9. A DNS server is only operable, or capable, of routing messages in the

manner claimed if the server is programmed or otherwise directed to do so. Because *Mead* does not disclose a DNS server that is programmed or otherwise directed to route messages in the manner claimed, the Examiner's rejection should be reversed.

The Examiner states that "there is no requirement that the DNS server is programmed or otherwise directed to perform any functionality." Examiner's Answer, p.30. But the Examiner also states that "a DNS server is operable to route messages to any destination that it is **directed** to route the messages." Id. Thus, even the Examiner acknowledges that a DNS server is operable to route messages to a destination only if it is **directed** to route the messages to that destination. Because *Mead* does not disclose directing a DNS server to route messages in the manner indicated by claim 9, *Mead* does not anticipate claim 9, or claims 11-13 and 15-19, which depend from claim 9.

IV. The Examiner inadvertently omitted withdrawing the rejection of claim 18 as indefinite.

Appellant acknowledges that the Examiner inadvertently omitted from the Advisory Action mailed April 25, 2008 a statement that the rejection of claim 18 as indefinite under 35 U.S.C. § 112 was withdrawn. Examiner's Ans., p.31. Appellant submits that claim 18 is not indefinite under 35 U.S.C. § 112, and that this rejection should be reversed by the Board.

Respectfully submitted,

By: 

Mark C. Young, Reg. No. 48,670
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2900
Kansas City, MO 64106
Telephone: (816) 842-8600
Facsimile: (816) 691-3495